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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,491	04/03/2006	Yukio Yoshida	287412US0PCT	2353
22850	7590	05/10/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
VASISTH, VISHAL V				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
05/10/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/574,491

Applicant(s)

YOSHIDA ET AL.

Examiner

VISHAL VASISTH

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. Applicants' response filed on 1/6/2010 added dependent claims 21-22, but no other amendments were made to the claims. Applicants' arguments also filed on 1/6/2010 were persuasive regarding the 35 USC 102 rejection over Yoshida and the 35 USC 103 rejection over Yoshida in view of Matsuno from the office action mailed on 10/7/2009, therefore these rejections have been withdrawn. A new rejection is set forth below.

Claim Rejections - 35 USC § 102

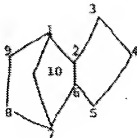
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7, 9, 13-15, 19 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Vojacek et al., EP Publication No. 0082967 (hereinafter referred to as Vojacek).

Vojacek discloses traction drive fluid compositions comprising a mixture of hydrocarbons including tricyclo [5.2.1.0^{2,6}] decane represented by the formula (which reads on claim 1) (Page 8):



and cyclopropane-[1-spiro-2]-norbornane and 4,8, 8-Trimethyl-9-formyl-decahydro-1, 4-methano-azulene (which read on claims 3, 7, 9, 15 and 19) (Page 5, paragraph 4). It is the position of the examiner that since Vojacek discloses the hydrocarbon recited in instant claim 1 that the hydrocarbon inherently has a viscosity at -40°C of 30 Pa-s or lower (as recited in claims 2 and 21-22) and a viscosity index of 80 or higher.

Vojacek further discloses additives that can be present along with the hydrocarbons disclosed above and include antioxidants, antifoaming agent, dispersing agent, viscosity index improver and extreme pressure additives (as recited in claim 13-14).

Claim Rejections - 35 USC § 102

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Osawa et al., Non-Patent Literature document entitled: "The Mechanisms of Carbonium Ion Rearrangements of Tricycloundecanes Elucidated by Empirical Force Field Calculations February 14th, 1977 (hereinafter referred to as Osawa).

Osawa discloses hydrocarbon compounds such as Spiro[cyclopentane-1-7'-norbornane], Spiro[cyclopentane-1-2'-norbornane], (4R, 7S)-[5.2.2.0^{4,8}] chair-chair and other hydrocarbons in Table 1 that read on the instant claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vojacek in view of Wygant, US Patent No. 3,803,037 (hereinafter referred to as Wygant).

Vojacek discloses all of the limitations discussed above including an alicyclic base oil used in combination with the other traction base oils. Vojacek does not explicitly disclose the base oil reading on formula (h) of claim 10.

Wygant discloses a traction drive fluid composition (Col. 2/L. 5-7) comprising base oils including 2,4-dicyclohexyl-2-methylpentane and 2,3-dicyclohexyl-2,3-dimethylbutane (as recited in claims 10-12) (Col. 2-3/L. 47-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the alicyclic base oils of Wygant in the composition of Vojacek because of their good lubricating properties and relatively high coefficient of frictions (Col. 2/L. 22-24 of Wygant).

Claim Rejections - 35 USC § 103

8. Claims 9 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vojacek in view of Osawa.

Vojacek discloses all of the limitations disclosed above including a combination of hydrocarbon compounds that functions as traction drive fluid base oils. Vojacek does not explicitly disclose all of the hydrocarbons recited in the instant claims.

Osawa discloses all of the hydrocarbons discussed above. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the hydrocarbons disclosed in Osawa in the composition of Vojacek as suitable replacements to the hydrocarbons disclosed in Vojacek.

Response to Arguments

9. Applicants' arguments filed on 1/6/2010 with respect to claims 1-22 have been considered but are moot in view of the new grounds of rejection.

Vojacek and Osawa disclose hydrocarbon compounds that read on the instant claims. Vojacek further discloses the hydrocarbons present in a traction drive fluid along with additional additives including additional hydrocarbon base oils.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Glenn A Caldarola/
Supervisory Patent Examiner, Art
Unit 1797

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